UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,367	04/09/2004	I-Sing Roger Niu	P4509C1	1193

24739 7590 09/14/2007

CENTRAL COAST PATENT AGENCY, INC
3 HANGAR WAY SUITE D
WATSONVILLE, CA 95076

EXAMINER	
HYUN, SOON D	
ART UNIT	**PAPER NUMBER**
2616	
MAIL DATE	**DELIVERY MODE**
09/14/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/821,367	NIU ET AL.	
	Examiner	Art Unit	
	Soon D. Hyun	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *4/9/07*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 1 2, 4, 9, 11, 18, and 25 are objected to because of the following informalities:

In claims 1 and 2, line 9 and line 1, respectively, "facility" should be amended to – component -- to avoid lack of antecedent basis.

Each of claims 4, 9, 11, 18 and 25 recites a limitation "capable of " which is not a positive recitation. Under MPEP 2111.04, "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim limitation."

Appropriate correction is required.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 3, 4, 6, 7, 10, 11, 13, 14, 17, 18, 20, 21, 24, 25, 27 and 28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 2, 4-7, 9-12,

and 14-17, 19 and 20, respectively of prior U.S. Patent No. 6,712,312. This is a double patenting rejection.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 2, 5, 8, 9, 12 15 16, 19, 22, 23, and 26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim1-3, 6-8, 11-13, and 16-18 of U.S. Patent No. 6,712,312. respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are not patentably distinct from each other because each corresponding claim of Patent No. 6,712312 contains every element of the corresponding claim of the instant application and as such anticipates the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of

obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Moreover, omission of a reference element whose is not needed would be obvious tone of ordinary skill in the art. It well settled that the omission of an element and its functions is an obvious expedient if the remaining elements perform the same function as before168 USPQ 375 (Bd..App. 1969). In re Karlson, 163 USPQ 184 (CCPA 1963). Also note Ex parte Rainu.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 8, 15 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Wicklund (U.S. patent No. 6,295,295).

Regarding claims 1, 15 and 22, Wicklund discloses a fabric card, a packet switch, a router (FIG. 2) for routing data packets comprising:

a plurality of ingress/egress ports (8 and 12);

a switching component (switch core 3) through which the ports connect; and

a scheduling component (a packet transfer scheduler18) for scheduling communication between the plurality of ports through the switching component;

wherein that data (ATM cells) coming into one of the plurality of ports is organized into specific data-packet trains (Current list 42), each having an end-of-train (EOT) identifier (an explicitly value or one single bit marker in the last cell of the Current list 42, col. 7, lines14-20) and the switch recognizes the EOT identifiers and switches transmission to a next port and train accordingly and to recognize the end the train (Current list 42).

However, Wicklund does not teach that a mark in a cell indicating a start-of-train (SOT) in the Current list 42 as recited in the claims.

it would have been obvious to one having ordinary skill in the art to incorporate a mark indicating the start of the train into the first cell of the Current list as well as the end of train mark such that the switch could recognize the boundary of the train more clearly.

Regarding claims 2, 5, 9, 12, 16, 19, and 23 and 26, Wiklund teaches that the switch core 3 (cross points) ha buffers (D-FIFOs) to avoid cells between two input ports addressing to a same output port (col. 5, lines 63-65).

However, Wicklund fails to explicitly teach a plurality of ASIC incorporated for the switch.

It is an **Official Notice** that a system is implemented as ASIC is well known in the art to provide desired scalability.

Therefore, it would have been obvious to one having ordinary skill in the art to incorporate a plurality of ASICs into the switch of Wicklund to provide a desired scalability for the switching system.

Regarding claim 8, Refer to the claim 1, Wicklund further discloses that different linked cells are associated with VPI/VCI connections queued in a VPI/VCI list 50 (FIG. 3) in the scheduler; input port sends out a co-ordination packet (requesting permission) via the Scheduled and are collected by the output port, when the particular cell trains are transmitted, the output port send a Start-of-List (col. 10, lines 21-28).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Soon D. Hyun whose telephone number is 571-272-3121. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H. Pham can be reached on 571-272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Hyun
9/10/2007

CHI PHAM
SUPERVISORY PATENT EXAMINER 9/11/07